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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,217	10/15/2003	Eduard K. de Jong	SUN040202	8110
24209 7590 02/28/2007 GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940			EXAMINER CERVETTI, DAVID GARCIA	
			ART UNIT	PAPER NUMBER
			2136	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/687,217

Applicant(s)

DE JONG, EDUARD K.

Examiner

David G. Cervetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/27/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-100 are pending and have been examined.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because: reference character "195" has been used to designate both "digital content producer" (page 5) and "authenticators" (page 5). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. **This is not intended to be a complete list of such informalities.**

Specification

4. The disclosure is objected to because of the following informalities: the reference to application numbers provided in pages 2-4 needs to be updated to reflect applications that have matured into patents. Appropriate correction is required.
5. The disclosure is objected to because of the following informalities: "ATM" (page 23), "CGI", "HTTP" (page 25). These terms have not been defined. Appropriate correction is required.

6. **This is not intended to be a complete list of such informalities.**

Claim Objections

7. Claims 9, 14, 19, 28, 33, 38, 47, 52, 57, 74, 87, 100 are objected to because of the following informalities: "HTTP" must be spelled out. Appropriate correction is required.

Double Patenting

8. Claims 1-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-88 of copending Application No. 10/687,488. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully claimed in the referenced copending application.

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. The subject matter claimed in the instant application is fully claimed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

- the instant application claims **a method for digital content access control, comprising:**
 - o **determining digital content to be made accessible via a rights locker** describing a user's access rights for digital content associated with said rights locker;

- **determining enrollment authentication data;**
- **sending a rights locker enrollment request to a rights locker provider, said rights locker enrollment request comprising a digital content request and said enrollment authentication data;**
and
- **receiving an authenticated rights locker access request in response to said sending, said authenticated rights locker access request for subsequent use in accessing digital content associated with said rights locker (claim 1);**
- **the copending application claims a method for digital content access control, comprising:**
 - **determining digital content to be made accessible via a rights locker;**
 - **determining enrollment authentication data;**
 - **sending a rights locker enrollment request to a rights locker provider, said rights locker enrollment request comprising a digital content request and said enrollment authentication data;**
 - **receiving one or more authenticated rights locker access requests in response to said sending, said one or more authenticated rights locker access requests for subsequent use in accessing digital content associated with said rights locker;**

- receiving an indication of a selection of one of said one or more authenticated rights locker access requests;
- sending said authenticated rights locker access request to a rights locker provider; and
- receiving a result in response to said sending said authenticated rights locker access request (claim 1).

11. Claims 1-100 of the instant application are envisioned by copending Application No. 10/687,488's claims 1-88 in that claims 1-88 of the copending application contain all the limitations of claims 1-100 of the instant application. Claims 1-100 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. Both provide digital content access control, a rights locker, and enrollment data.

12. Claims 1-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-88 of copending Application No. 10/687,459. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully claimed in the referenced copending application.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. The subject matter claimed in the instant application is fully claimed in the referenced copending application and would be covered by any patent granted on that

copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

- the instant application claims **a method for digital content access control, comprising:**
 - **determining a digital content specification and associated authenticated rights locker access request;**
 - **sending said authenticated rights locker access request and said digital content specification;**
 - **receiving a new authenticated rights locker access request in response to said sending; and**
 - **receiving said digital content in response to said sending (claim 15);**
- the copending application claims **a method for digital content access control, comprising:**
 - **determining a digital content specification and associated authenticated rights locker access request;**
 - **sending said authenticated rights locker access request and said digital content specification;**
 - **receiving a new authenticated rights locker access request and a Web page with one or more clickable links in response to said sending, at least one of said one or more clickable links associated with an authenticated digital content request;**

- receiving an indication of a user selection of one of said one or more clickable links;
- sending an authenticated digital content request associated with said one of said one or more clickable links to a digital content repository; and
- **receiving said digital content in response to said sending said authenticated digital content request** (claim 1).

15. Claims 1-100 of the instant application are envisioned by copending Application No. 10/687,459's claims 1-88 in that claims 1-88 of the copending application contain all the limitations of claims 1-100 of the instant application. Claims 1-100 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting.

Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 65, 78, and 91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 65, 78, and 91 contain the trademark/trade name "Java Card". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App.

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1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a smart card and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. **Claims are rejected under 35 U.S.C. 102(e) as being anticipated by Buhse et al. (US Patent Application Publication 2004/0024652, hereinafter Buhse).**

Regarding claims 1, 20, 39, and 58, Buhse teaches

- determining digital content to be made accessible via a rights locker describing a user's access rights for digital content associated with said rights locker (**par. 154-158**);
- determining enrollment authentication data (**par. 160-172**);

- sending a rights locker enrollment request to a rights locker provider, said rights locker enrollment request comprising a digital content request and said enrollment authentication data (**par. 123-135**); and
- receiving an authenticated rights locker access request in response to said sending, said authenticated rights locker access request for subsequent use in accessing digital content associated with said rights locker (**par. 132-135**).

Regarding claims 10, 29, 48, and 75, Buhse teaches

- determining a digital content specification and associated authenticated rights locker access request (**par. 154-158**);
- sending said authenticated rights locker access request and said digital content specification (**par. 123-135**);
- receiving an authenticated digital content request and a new authenticated rights locker access request in response to said sending (**par. 132-135**);
- sending said authenticated digital content request (**par. 132-135**); and
- receiving said digital content in response to said sending said authenticated digital content request (**par. 132-135**).

Regarding claims 15, 34, 53, and 88, Buhse teaches

- determining a digital content specification and associated authenticated rights locker access request (**par. 154-158**);

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- sending said authenticated rights locker access request and said digital content specification (**par. 123-135**);
- receiving a new authenticated rights locker access request in response to said sending (**par. 132-135**); and
- receiving said digital content in response to said sending (**par. 132-135**).

Regarding claims 2, 21, 40, and 59, Buhse teaches wherein said digital content request comprises a request for initializing said rights locker with rights to specified digital content (**par. 154-161**).

Regarding claims 3, 22, 41, and 60, Buhse teaches wherein said enrollment authentication data comprises: rights locker access authentication data for determining what rights, if any, said user has to access said rights locker; and rights content access authentication data for determining what rights, if any, said user has to digital content associated with said rights locker (**par. 154-161**).

Regarding claims 4, 23, 42, and 61, Buhse teaches wherein said rights locker access authentication data comprises payment for use of a rights locker service (**par. 154-161**).

Regarding claims 5, 24, 43, and 62, Buhse teaches wherein said rights content access authentication data comprises payment for rights deposited in said rights locker (**par. 154-161**).

Regarding claims 6, 25, 44, and 63, Buhse teaches wherein said enrollment authentication data comprises a reenrollment key determined in a previous enrollment

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request for said rights locker, said reenrollment key for supplementing or replacing enrollment authentication data of said previous enrollment request (**par. 123-131**).

Regarding claims 7, 12, 17, 26, 31, 36, 45, 50, 55, 72, 85, and 98, Buhse teaches storing at least part of said (new) authenticated rights locker access request in a bookmark on said user device (**par. 181-190**).

Regarding claims 8, 13, 18, 27, 32, 37, 46, 51, 56, 73, 86, and 99, Buhse teaches wherein said (new) authenticated rights locker access request is embedded in a Web cookie (**par. 181-190**).

Regarding claims 9, 14, 19, 28, 33, 38, 47, 52, 57, 74, 87, and 100, Buhse teaches wherein said (new) authenticated rights locker access request is encapsulated in an HTTP Response message (**par. 181-190**).

Regarding claims 11, 16, 30, 35, 49, 54, 76, and 89, Buhse teaches wherein said method further comprises determining one or more delivery parameters, said one or more delivery parameters indicating where said digital content should be sent, a delivery mechanism, or both; and said sending further comprises sending said one or more delivery parameters (**par. 218-229**).

Regarding claims 64, 77, and 90, Buhse teaches wherein said apparatus comprises a smart card (**par. 40-45, 72, 236-238**).

Regarding claims 65, 78, and 91, Buhse teaches wherein said smart card comprises a Java Card.TM. technology-enabled smart card (**par. 40-45, 72, 236-238**).

Regarding claims 66, 79, and 92, Buhse teaches wherein said smart card comprises a CDMA (Code Division Multiple Access) technology-enabled smart card (**par. 40-45, 72, 236-238**).

Regarding claims 67, 80, and 93, Buhse teaches wherein said smart card comprises a SIM (Subscriber Identity Module) card (**par. 40-45, 72, 236-238**).

Regarding claims 68, 81, and 94, Buhse teaches wherein said smart card comprises a WIM (Wireless Interface Module) (**par. 40-45, 72, 236-238**).

Regarding claims 69, 82, and 95, Buhse teaches wherein said smart card comprises a USIM (Universal Subscriber Identity Module) (**par. 40-45, 72, 236-238**).

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Regarding claims 70, 83, and 96, Buhse teaches wherein said smart card comprises a UIM (User Identity Module) (**par. 40-45, 72, 236-238**).

Regarding claims 71, 84, and 97, Buhse teaches wherein said smart card comprises a R-UIM (Removable User Identity Module) (**par. 40-45, 72, 236-238**).

Conclusion

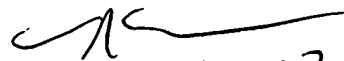
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

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2,23,07